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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,067	03/19/2004	Naohiro Toda	250758US0	8252
22850	7590	11/27/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			RODEE, CHRISTOPHER D	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/804,067

Applicant(s)

TODA ET AL.

Examiner

Christopher RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-18 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-18 and 20-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claim 19 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected photoconductor, apparatus, and process cartridge, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 26 May 2006.

Information Disclosure Statement

The IDS filed 21 August 2006 and 27 September 2006 have been considered.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 12 and 27 remain rejected under 35 U.S.C. 102 (a) and/or 102(e) as being anticipated by Toda *et al.* in US Patent Application Publication 2004/0053149.

In response to this rejection as previously set forth applicants have amended the claims to include the limitation of claim 11. This claim specified that the charge transport layer comprises polycarbonate having a triarylamine structure in at least one of principal chain and side chain thereof. As noted in the last Office action, Example 17 discloses a photoreceptor where that the charge transport layer has a polycarbonate charge transport polymer with tertiary amine groups. Thus this example combined with the remaining disclosure of the reference identically discloses the now claimed feature.

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Applicants have also provided a certified translation of the priority document under Rule 55 to obtain § 119 benefit. A review of the priority document shows that the document does not disclose a surface protection layer above the charge transport layer. The priority document does disclose a surface protection layer on the charge transport layer (¶ [0033]) but it fails to disclose a surface protection layer above the charge transport layer. Presumably, this includes intervening layer(s) between the charge transport and surface protection layer. The priority document does not disclose this embodiment.

The priority document also does not disclose a process cartridge as in pending claim 27. In claim 27 each of the units is presented in the alternative. The priority document at ¶ [0080] discloses each of certain units as required. The presence of only a single charging unit, developing unit, transferring unit, or cleaning unit, or some combination of less than all of them is not disclosed.

Because the above noted claims are not described by the priority document within the meaning of § 112, first paragraph, applicant is not entitled to priority for these claims. See MPEP 201.15.

Double Patenting

Claims 1-10, 12-18 and 20-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7-23, 28, and 29 of copending Application No. 10/606750 in view of Ishii *et al.* in US Patent Application Publication 2002/0064721. The copending application claims a photoreceptor that differs from the instant claims only in the characteristics of the polyvinylbutyral resin for the charge generation layer. Ishii discloses a commercially available polyvinyl butyral resin for a charge generation layer. The polyvinylbutyral is S-LEC BX-1, which has a Mw/Mn ratio of 3.1 and Mn of 120,000. It

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would have been obvious to one having ordinary skill in the art at the time the invention was made to use the commercially available polyvinyl butyral in the claims of the copending application as the resin because the artisan would have found it necessary to select a specific polyvinyl butyral resin to practice the invention of the copending claims and Ishii discloses an effective polyvinyl butyral resin for this purpose in the same field of endeavour.

This is a provisional obviousness-type double patenting rejection.

Because this is not the only rejection remaining in the application, it will be maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on Monday to Thursday from 5:30 to 4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

cdr
20 November 2006



CHRISTOPHER RODEE
PRIMARY EXAMINER